

REMARKS

The applicants have carefully considered the Office action dated February 6, 2009, and the references it cites. By way of this Response, claim 61 has been amended. In view of the following, it is respectfully submitted that all pending claims are in condition for allowance and favorable reconsideration is respectfully requested.

Art Rejections

The Office action mailed February 6, 2009, is substantially a repeat of the prior rejection. In particular, the Office action again rejected all pending claims as being unpatentable over Houston, U.S. Patent 6,353,929, and one or more of Ozkan, U.S. Patent 6,031,577, Lotspiech et al., U.S. Patent 6,118,873, Gerace, U.S. Patent 5,848,396, Ciciora, U.S. Patent 5,815,297, Williams, U.S. Patent 6,259,443, Kaufman, U.S. Patent 5,003,591, Saito, U.S. Patent 6,751,221, and Welsh, U.S. Patent 5,374,951. The applicants respectfully traverse these rejections.

Proper Analysis of the Cited Art and the Submitted 132 Declaration

As mentioned in the previous response dated December 3, 2007, because all of the rejections are based on the Houston Patent, the applicants contacted John Houston, the named inventor of the Houston Patent, and asked him to evaluate the positions taken by the Examiner. Mr. Houston was available for contact because the Houston Patent has been assigned of record to the assignee of the instant application, and because John Houston is a paid consultant of the assignee. The applicants sought Mr. Houston's candid view of the rejections based on the Houston Patent. As shown in the 132 Declaration submitted with the December 3, 2007 response, Mr. Houston does not agree with the Examiner's reading of the Houston Patent. Instead, Mr. Houston's declaration provides strong and compelling evidence that the Examiner's reading of the Houston Patent is in error, and that the positions taken by the applicants for patentability are correct.

Obviousness Analysis

Recently, in April 2009, the U.S. Court of Appeals for the Federal Circuit in addressed review of prior art references and obviousness analysis in view of those prior references following the *KSR* decision. *In re Kubin*, 2008-1184 (Fed. Cir. April 3, 2009)(Serial No. 09/667,859). As noted by the court, an analysis of obviousness must be based on several factual inquiries:

- (1) the scope and content of the prior art;
- (2) the differences between the prior art and the claims at issue;
- (3) the level of ordinary skill in the art at the time the invention was made; and
- (4) objective evidence of nonobviousness, if any.

Citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

In *Kubin*, the court noted that something may be obvious to try but not obvious under 103 if someone would have to “vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.” (quoting *In re O’Farrell*, 853 F. 2d 894, 903 (Fed. Cir. 1988)). As a corollary, one could argue that when there are many known options available to accomplish a task, one of ordinary skill would have no motivation to try to search for another solution.

Response to Rejections

In the present application, the sole inventor of the primary reference used to reject the pending claims of the present application, John Houston, who should at the very least be considered a person of ordinary skill in the art, has stated that

5. With respect to independent claims 13, 61 and 79 of the '224 application as presented with the Response to the Office action of August 1, 2007 filed herewith, *my patent makes absolutely no mention of collection and/or timestamping PID headers as a useful vehicle for performing media monitoring*. While it is true that the methods and apparatus disclosed in my patent could certainly collect such PID headers (the methods and apparatus I disclosed can be used to collect virtually any type of media measurement data), my patent does not specifically disclose the concept of collecting and/or timestamping such PID headers or in anyway indicate that collecting and/or timestamping such PID headers would be of interest. *Therefore, in my opinion, the only way a person of ordinary skill in the art at the relevant time frame reading my patent would be led to collect and timestamp PID headers, is if that person had a priori knowledge of the value of collecting such PID headers from another source.*

6. *My patent described collecting payload data which may be associated with PID headers and, thus, in my opinion my patent does not by itself motivate someone to collect and timestamp PID headers.*

(Houston Declaration, Paragraphs 5-6)(emphasis added). Therefore, in response to the Office action dated August 1, 2007, the applicant argued:

[Houston] teaches recording the payload data of the PID, and which has more information than the PID alone. Consequently, there is no motivation to store the PID information of [Houston] in that the [Houston] system already has similar information (derived from the payload portion but not the PID per se) stored.

Thus, applicants submit that they have provided compelling evidence that Houston collects payload information and, thus, has no need to collect PID headers to achieve its monitoring function.

There is no motivation to modify Houston to collect the PID headers themselves. The level of ordinary skill in the art and secondary considerations of nonobviousness based on

efforts in the marketplace support the lack of obviousness or motivation to try to develop the claimed systems, apparatus, and methods. The Office action acknowledges that “Houston does not disclose a system wherein the program identification is located within a PID header; and wherein the PID header is broadcast with the data packet to enable the digital equipment to tune to a selected one of a plurality of minor channels broadcast in a major channel.”

Ozkan is similarly ineffective in arriving at the system recited in claim 13. While Ozkan mentions that content packets include packet identifiers (PIDs), Ozkan matches incoming packet PIDs with pre-loaded PID values for channel tuning and to provide ancillary program guide and alphanumeric text information to a viewer. See, e.g., col. 1, lines 50-60, col. 2, lines 51-55, col. 5, lines 8-17 and lines 35-62. Ozkan assembles multiple text strings associated with a program into an output text string providing alphanumeric program guide information to a viewer. See, e.g., Abstract and col. 3, line 54 – col. 4, line 3. Thus, when a viewer wishes to see information regarding what programs are on television (e.g., an Electronic Program Guide), the viewer can pull up this information on his or her television using a remote control. See, e.g., Figs 1 and 10, col. 3, line 61 – col. 4, line 3. The television uses the program information to tune to a desired channel and assemble data packets to form complete programs and visible alphanumeric program guides, rather than to track viewing habits. See, e.g., Figs. 1 and 10, and col. 3, line 61 – col. 4, line 3.

Based on a review of Houston, Ozkan, and Houston’s 132 declaration regarding the Houston patent, it is clear that, at the time of the invention, it would not have been obvious for one of ordinary skill in the art to read a PID header from a data packet containing a portion of a tuned digital television program to identify the television program tuned by the digital television equipment, wherein the software agent reading the PID header stores at least a portion of the PID header in association with a timestamp. It would not have been obvious to transmit at least one of the at least the portion of the PID header and media identification

information obtained via the PID header to a remotely located central office from a statistically selected location.

Based at least on the Houston declaration, the motivation to combine would have been absent at the time of invention. There was no need to modify Houston to collect PID headers in order to have access to a “standardized program identifier” because standardized program identifiers were already present in Houston. Any analysis to the contrary relies upon an impermissible use of hindsight from today looking back to the time of invention of the presently pending claims (i.e., presumptively at least May 12, 1998).

Further, Mr. Houston states that the Houston patent is not directed to a tuning device.

Mr. Houston states:

3. I have reviewed the final Office action's argument that my patent is directed toward a tuning device. However, I respectfully submit that the Examiner misunderstands my disclosure when he describes it as a tuning device. My patent is directed toward an audience measurement system. It is not a tuning device and it does not seek to affect how audience members utilize their tuning devices nor does it seek to affect how such tuning devices operate to tune programs. Instead, specifically with respect to tuning devices, my patent relates to measuring how audience members utilize their own tuning devices. As such, there is no reason apparent to me to modify my patent to enable tuning of any sort, let alone to enable tuning “to sub-channels without acquiring the program map table (PMT)” as stated in the Office action.

(Houston Declaration, Paragraph 3).

The applicants respectfully submit that, in view of these elements missing from both Houston and Ozkan, as well as a lack of motivation to combine the references, the suggested combination of Houston and Ozkan cannot render claim 13 *prima facie* obvious. Accordingly, the applicants respectfully submit that independent claim 13 and all claims dependent thereon are in condition for allowance.

The applicants respectfully submit that independent claim 61 is also allowable over the art of record. Claim 61 recites, *inter alia*, first instructions ***to store and timestamp at least***

a portion of a television program identification (PID) header from a data packet containing a portion of a tuned television program to identify the television program selected for viewing on the digital television equipment. For at least the reasons discussed above in connection with claim 13, the applicants respectfully submit that the suggested combination of Houston and Ozkan cannot render claim 61 *prima facie* obvious. Accordingly, the applicants respectfully submit that independent claim 61 and all claims dependent thereon are in condition for allowance.

The applicants respectfully submit that independent claim 79 is also allowable over the art of record. Claim 79 recites, *inter alia, storing and timestamping at least a portion of a television program identification (PID) header from a data packet containing a portion of a tuned television program to identify the television program selected for viewing* on the digital television equipment. For at least the reasons discussed above in connection with claim 13, the applicants respectfully submit that the suggested combination of Houston and Ozkan cannot render claim 79 *prima facie* obvious. Accordingly, the applicants respectfully submit that independent claim 79 and all claims dependent thereon are in condition for allowance.

Turning to the rejections of independent claims 62 and 80, the Office action points out that “Houston does not disclose an apparatus wherein the reader is for use by a media device different from the digital television program reception equipment; and the data port operates in accordance with the IEEE 1394 protocol and the program identifying data read by the reader are identifier tags exported with the data in accordance with the IEEE 1394 protocol.” The Office action also states that “Houston and Welsh do not disclose apparatus wherein the data port operates in accordance with the IEEE 1394 protocol and the program identifying data read by the reader are identifier tags exported with the data in accordance with the IEEE 1394 protocol.”

As explained previously, the rejection is based on a hindsight effort to re-create the inventions of independent claims 62 and 80 of the application by combining Houston, Welsh, and Saito. However, this alleged combination requires a fundamental contortion of Houston that would only be considered if one already had the applicants' invention firmly in mind (i.e., with hindsight reference to the applicants' own disclosure). As explained by Mr. Houston himself:

4. The cooperative media handler methods disclosed in my patent provide access to a rich amount of audience measurement data, so there is nothing to be gained by employing eavesdropping methods such as those disclosed in the '224 application when my disclosed methods are available. Therefore, in my opinion, a person of ordinary skill in the art reading my patent in the relevant time frame would not be led by my disclosure to the invention recited in claims 62 and 80 of the '224 application as currently presented in the response to the Office action of August 1, 2007 filed herewith. *Quite simply, the techniques I disclose and the techniques recited in claims 62 and 80 relate to fundamentally different approaches to media measurement. Since my patent has no need of eavesdropping techniques such as those recited in claims 62 and 80, in my opinion, no person of ordinary skill in the art reading my patent would take it as suggesting the eavesdropping techniques of the '224 application.*

(Houston Declaration, Paragraph 4)(emphasis added).

The Office action admits that neither Houston nor Welsh recite the system of claim 62. Saito does nothing to cure these defects, merely mentioning that IEEE 1394 firewire technology exists and can be used in networks. See, e.g., col. 1, lines 56-65. Saito contains no disclosure regarding identifying a viewer selected television program from among a plurality of time overlapped television programs broadcast in a viewer selected broadcast channel and received by digital television program reception equipment. Saito contains no disclosure of, inter alia, reading program identifying data from among data exported from the digital television program reception equipment via a data port for use by a media device different from the digital television program reception equipment, wherein the data port operates in accordance with the IEEE 1394 protocol and the program identifying data read by

the reader are identifier tags exported with the data in accordance with the IEEE 1394 protocol.

The rejections ignore the fact that claim 62 recites *reading program identifying data including identifier tags* tuned by the digital television program reception equipment from among data exported from the digital television program reception equipment via the firewire (IEEE 1394) data port. Instead, the rejections merely argue it would be obvious to use a firewire port with Houston to communicate data among multiple units. However, using the firewire protocol for upstream communication might result in exporting the data collected *within the monitored device* by the Houston cooperative media handler, but it provides *no rationale for completely changing the data collection mechanism of Houston* from a software agent internal to a monitored media presentation device to a reader that eavesdrops on communications to a second device to collect program identification tags output via the firewire port of a monitored media presentation device. In other words, the motivation proposed by the Office action *might* lead one to forward the data collected internally by the Houston software agent upstream to the central data collection center, *but it would not lead one to replace the inventive Houston data collection mechanism with an external reader as* recited in claim 62.

In short, it is clear that none of Welsh, Houston or Saito contemplate using a reader coupled to an IEEE 1394 data port to eavesdrop to collect program identification tags from data communicated to a second media device. At most the Office action has identified a rationale for using IEEE 1394 communication protocols to transport data collected using the Houston cooperative media handler approach *internal* to the monitored device from the monitored device to an upstream device. However, the applicants make no claim to being the inventor of IEEE 1394, and the Office action has failed to identify any teaching or suggestion for exploiting IEEE 1394 communication as a vehicle for collecting *program identifying tags* from data exported to a second media device. Indeed, given Houston's access to detailed

audience measurement information *within* the monitored equipment via the cooperative media handler, there is no need for a reader coupled to an IEEE 1394 port of the monitored equipment to record identifier tags exported via the IEEE 1394 port of the monitored equipment. Therefore, the only reason anyone would read the Houston/Welsh/Saito combination as teaching such an external reader is with a priori knowledge of the invention of claim 62. Of course, such hindsight usage of the teachings of the applicants' invention is not a proper basis for rejecting the applicants' claims. Accordingly, claim 62 and all claims depending therefrom are in condition for allowance.

The applicants respectfully submit that independent claim 80 is also allowable over the art of record. Claim 80 recites, *inter alia*, intercepting program identifying data tuned by the digital television program reception equipment from among data exported from the digital television program reception equipment via the data port. The program identifying data includes identifier tags exported with the data in accordance with the IEEE 1394 protocol, and the program identifying data is exported to the second media device. For at least the reasons discussed above in connection with claim 62, the applicants respectfully submit that the suggested combination of Houston, Welsh, and Saito cannot render claim 80 *prima facie* obvious. Accordingly, the applicants respectfully submit that independent claim 80 and all claims dependent thereon are in condition for allowance.

In view of the foregoing, it is respectfully submitted that all pending claims are in condition for allowance. Reconsideration and passage of the application through to allowance is respectfully requested.

CONCLUSION

In general, the official action makes various statements regarding the pending claims and the cited references that are now moot in light of the above. Thus, the applicants will not address such statements at the present time. However, the applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

In view of the foregoing, the applicants respectfully request reconsideration of this application. If there are any remaining matters that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below. The Commissioner is authorized to charge any necessary fees or credit any overpayment to Deposit Account No. 50-2455.

Respectfully submitted,

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